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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/598,859

05/14/2009

Massimo Losio

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EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3765

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/598,859	<b>Applicant(s)</b> LOSIO, MASSIMO	
	<b>Examiner</b> MARIE PATTERSON	<b>Art Unit</b> 3765	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on \_\_\_\_; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 5) ☒ Claim(s) 1 and 3-18 is/are pending in the application.
- 5a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 6) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 7) ☒ Claim(s) 1 and 3-18 is/are rejected.
- 8) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 9) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/13/06</u> . | 6) <input type="checkbox"/> Other: ____.  |

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 3-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the phrase “upper surface is visible from the outside” is confusing, vague, and indefinite.

Claims 8 and 10 are confusing, vague, and indefinite. It is not clear what structural limitations applicant intends to encompass with such language.

Claim 11 is confusing, vague, and indefinite because no such appendage has been shown and therefore it is not clear what structural limitations applicant intends to encompass with such language.

In claim 13 the phrase “molding it in a special mold” is confusing, vague, and indefinite. It is not clear what constitutes a “special mold”.

***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the insole claimed in claim 11 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended

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replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4, 5, and 7-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bain (2004425) in view of Hardt (6598319).

Bain shows an insole comprising a front portion (A) and a rear cushioning portion (D) substantially as claimed except for the material for the front portion and cushioning portion. Hardt teaches the use of gel as a material for a heel cushioning portion (24)

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and teaches the use of transpiring materials (42) for a front portion. It would have been obvious to use gel and transpiring materials as taught by Hardt for the materials for the insole of Bain to provide increased comfort and cushioning.

In reference to claims 5, 17, and 18, Hardt teaches providing means for reducing the tackiness of the top of the gel by providing a means on the surface of the mold to reduce the tackiness of the top of the gel (see column 5 lines 20-35) substantially as claimed except for the exact means. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use varnish, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

In reference to claim 12, Hardt teaches providing a metatarsal insert (26). It would have been obvious to provide additional inserts such as a metatarsal insert as taught by Hardt in the insole of Bain to increase comfort and cushioning.

In reference to the exact method of making/molding the insole (claims 13-18), Hardt teaches many conventional methods of forming an insole having both gel elements and non gel elements and further states "Alternative methods of construct includinde press fitting...." (see column 5 lines 12-15). It would have been obvious to use such methods as specifically described by Hardt and as suggested and conventional well known methods to form the insole of Bain as modified above to reduce cost, improvide efficiency, to allow a particular material to be used, etc.

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6. Claims 1, 3, 5, 7, and 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (2862313) in view of Hardt (6598319).

Jones shows an insole comprising a transpiring (leather) front portion (10) and a rear cushioning portion (16), and a metatarsal cushionin portion (14, 15, and 17) substantially as claimed except for the material for the cushioning portion. Hardt teaches the use of gel as a material for a heel cushioning portion (24). It would have been obvious to use gel as taught by Hardt for the materials for the cushioning elements of Jones to provide increased comfort and cushioning.

In reference to claims 5, 17, and 18, Hardt teaches providing means for reducing the tackiness of the top of the gel by providing a means on the surface of the mold to reduce the tackiness of the top of the gel (see column 5 lines 20-35) substantially as claimed except for the exact means. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use varnish, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

In reference to the exact method of making/molding the insole ( claims 13-18), Hardt teaches many conventional methods of forming an insole having both gel elements and non gel elements and further states "Alternative methods of construct includinde press fitting...." (see column 5 lines 12-15). It would have been obvious to use such methods as specifically described by Hardt and as suggested and conventional well known

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methods to form the insole of Jones as modified above to reduce cost, improve efficiency, to allow a particular material to be used, etc.

7. Claims 1, 3, 5-7, and 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Silver (2083581) in view of Hardt (6598319).

Silver shows an insole comprising a transpiring (leather) front portion (11) and a rear cushioning portion (26), and a metatarsal cushioning portion (19) substantially as claimed except for the material for the cushioning portion. Hardt teaches the use of gel as a material for a heel cushioning portion (24). It would have been obvious to use gel as taught by Hardt for the materials for the cushioning elements of Silver to provide increased comfort and cushioning.

In reference to claims 5, 17, and 18, Hardt teaches providing means for reducing the tackiness of the top of the gel by providing a means on the surface of the mold to reduce the tackiness of the top of the gel (see column 5 lines 20-35) substantially as claimed except for the exact means. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use varnish, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

In reference to the exact method of making/molding the insole (claims 13-18), Hardt teaches many conventional methods of forming an insole having both gel elements and non gel elements and further states "Alternative methods of construct including press fitting...." (see column 5 lines 12-15). It would have been obvious to use such methods

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as specifically described by Hardt and as suggested and conventional well known methods to form the insole of Silver as modified above to reduce cost, improve efficiency, to allow a particular material to be used, etc.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571)273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3765 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.

/Marie Patterson/  
Primary Examiner  
Art Unit 3765